

ALBRECHT DORSCHNER ET AL.  
USSN 09/678,766

- c) increasing the temperature of the mixture to cause a phase inversion and thereby to produce an O/W emulsion. --

cons  
A 2

--25. A method of tanning skin comprising topically applying to skin an effective amount therefor of an emulsion according to any one of claims 4-23. --

---

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

The disclosure was objected to as lacking a brief description of the drawings. In

ALBRECHT DORSCHNER ET AL.  
USSN 09/678,766

response, Applicants have supplied a brief description of the drawings.

The claims were objected to for their format. In response, Applicants have replaced the original claims by a new set of claims, which Applicants believe have the proper format.

For the Examiner's information, the new claims correspond to the previous claims as follows:

<u>New Claims</u>	<u>Previous Claims</u>
4, 13	1
5, 14	1 (clause b)
6, 15	1 (clause b)
7, 16	1 (clause b)
8-10, 17-19	2
11-12, 20-21	3
24	New; supported by page 16, first two paragraphs
25	New; supported by pages 29-30 and the examples

No new matter has been added.

ALBRECHT DORSCHNER ET AL.  
USSN 09/678,766

Claims 1-3 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants point out that the new claims have the “particular” and “preferred” embodiments in dependent claims.

For the record, Applicants emphasize that although the claims were revised to overcome this rejection, and, therefore, might be argued to have been amended for a reason substantially related to patentability, a fair reading of the revised claims will reveal that the departures from the previous claims were for clarification purposes only, and that Applicants did not narrow the claims in any material respect. Therefore, Applicants submit that the revised claims are entitled to the full range of equivalents.

Claims 1-3 were rejected under 35 USC § 102(b) as being anticipated by Ascione et al. (“Ascione”), U.S. Patent No. 5,858,334. In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, the absence in the prior art reference of even a single one of the claim elements is sufficient to negate anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Ascione has no teaching of instant emulsifier A, the lipophilicity of which is dependent upon pH. Consequently, Ascione cannot anticipate the present claims.

ALBRECHT DORSCHNER ET AL.  
USSN 09/678,766

Claims 2 and 3 were rejected under 35 USC § 103(a) as being obvious over Ascione. In response, Applicants point out that this rejection was dependent upon Ascione constituting an anticipation of the basic aspects of the present invention, which, as is shown above, is not the case. Accordingly, Ascione also does not render obvious the subject matter of the present claims.

**Finally, Applicants point out that an information disclosure statement was filed on November 29, 2001, which included a completed Form 1449 for the Examiner to initial, thereby indicating the Examiner's consideration of the references cited in the information disclosure statement. The customary practice would have called for a copy of the initialed form to be returned to Applicants. However, to date, the copy of the initialed form has not been received. Therefore, Applicants respectfully request that the Examiner locate the form, and, if not already done, initial the form, and return a copy of the initialed form to Applicants along with the next Office Action or, hopefully, a Notice of Allowance. If the information disclosure statement and/or the Form 1449 is missing from the official file, then Applicants respectfully request that the Examiner telephone the undersigned at telephone number (212) 808-0700 so that a copy of the information disclosure statement and/or the Form 1449 can be provided to the Examiner on an expedited basis.**

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

ALBRECHT DORSCHNER ET AL.  
USSN 09/678,766

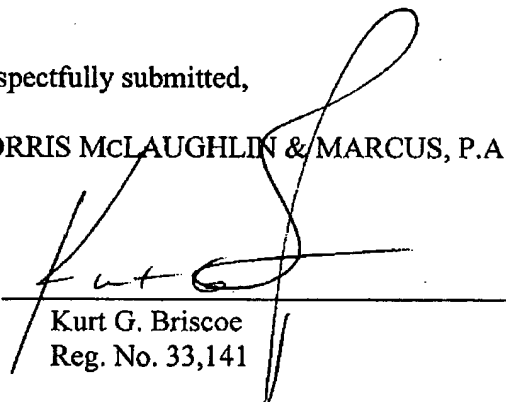
Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By

  
Kurt G. Briscoe  
Reg. No. 33,141

220 East 42<sup>nd</sup> Street  
30<sup>th</sup> Floor  
New York, New York 10017  
Phone: (212) 808-0700  
Fax: (212) 808-0844

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the attached Petition for Extension of Time (14 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: February 25, 2002

By

  
Kurt G. Briscoe